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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,295	09/08/2003	Susan Caprio	C 80330	9742
27321	7590	09/14/2005	EXAMINER	
ALVIN S. BLUM 2350 DELMAR PLACE FORT LAUDERDALE, FL 33301			NÉGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	
DATE MAILED: 09/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,295

Applicant(s)

CAPRIO, SUSAN

Examiner

Ismael Negron

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on July 28, 2005 has been entered. Claims 1, 2, 5 and 6 have been amended. No claim has been cancelled, or added. Claim 1-8 are still pending in this application, with claims 1 and 5 being independent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over HSUEH (U.S. Pat. 6,334,692) and TSENG (U.S. Pat. 5,709,464).

3. HSUEH discloses an illuminated key holder having:

- **key holding means (as recited in claims 1 and 5), Figure 3, reference number 16;**
- **the holding means being for holding at least one key (as recited in claims 1 and 5), column 2, line 18;**
- **a housing (as recited in Claim 1), Figure 3, reference number 1;**

- **the housing being connected to the key holding means (as recited in Claim 1), as seen in Figure 3;**
- **a battery holder (as recited in Claim 1), Figure 3, reference number 7;**
- **the holder being located within the housing (as recited in Claim 1), as seen in Figure 3;**
- **the holder including first and second battery connections (as recited in Claim 1), Figure 3, reference numbers 6 and 18;**
- **a light source (as recited in claims 1 and 5), Figure 3, reference number 4;**
- **the light source being located within the housing (as recited in Claim 1), as seen in Figure 3;**
- **the light source being arranged to shine light out of the housing (as recited in Claim 1), inherent;**
- **a vibration switch (as recited in claims 1 and 5), Figure 3, reference number 26;**
- **the vibration switch being located within the housing (as recited in Claim 1), as seen in Figure 3;**
- **the vibration switch being activated by a preset vibration intensity (as recited in claims 1 and 5), column 2, lines 43-48;**
- **illumination means (as recited in Claim 5), Figure 3, reference number 1;**

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- **the illumination means being connected to the key holding means (as recited in Claim 5), as seen in Figure 3;**
- **a battery (as recited in Claim 5), Figure 3, reference number 10;**
- **a circuit (as recited in Claim 5), inherent; and**
- **the circuit being activated by the vibrating switch (as recited in Claim 5), column 2, lines 43-48.**

4. HSUEH discloses all the limitations of the claims, except:

- first switch means (as recited in Claim 1);
- the first switch means being located within the housing (as recited in Claim 1);
- the first switching means being activated by the vibration switch (as recited in Claim 1);
- the first switching means remaining closed for a preset time interval (as recited in Claim 1);
- second switch means (as recited in Claim 1);
- the second switch means activating the light source during the preset time interval (as recited in Claim 1);
- the preset intensity being greater than that resulting from purse operation (as recited in claim 2 and 6);
- the preset time interval being one minute or less (as recited in claims 3, 4, 7 and 8); and

- the circuit activating the light source for the preset time interval (as recited in Claim 5).

5. TSENG discloses an illumination device having:

- **a housing (as recited in Claim 1), Figure 1, reference number 1;**
- **a light source (as recited in claims 1 and 5), Figure 1, reference number 6;**
- **a vibration switch (as recited in claims 1 and 5), Figure 1, reference number 7;**
- **the vibration switch being located within the housing (as recited in Claim 1), as seen in Figure 1;**
- **the vibration switch being activated by a preset vibration intensity (as recited in claims 1 and 5), column 2, lines 9-15;**
- **first switch means (as recited in Claim 1);**
- **the first switch means being located within the housing (as recited in Claim 1), Figure 1, reference number 3;**
- **the first switching means being activated by the vibration switch (as recited in Claim 1), column 2, lines 9-12;**
- **the first switching means remaining closed for a preset time interval after activation (as recited in Claim 1), column 2, lines 12-17;**
- **second switch means (as recited in Claim 1), Figure 1, reference number 3;**

- **the second switch means activating the light source during the preset time interval (as recited in Claim 1), column 2, lines 9-17;**
- **illumination means (as recited in Claim 5), Figure 1, reference number 1;**
- **a battery (as recited in Claim 5), Figure 1, reference number 2;**
- **a circuit (as recited in Claim 5), Figure 1, reference number 4;**
and
- **the circuit being activated by the vibrating switch (as recited in Claim 5), column 2, lines 9-12;**
- **the circuit activating the light source for the preset time interval (as recited in Claim 5), column 2, lines 9-17.**

6. Regarding the first and second switching means (as recited in Claim 1), such means were considered as inherently included by the circuit topology of the integrated circuit of TSENG, as they are required to perform as disclosed by TSENG.

7. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the key holder of HSUEH with the illumination circuit of TSENG to obtain a key holder including vibration activated lighting means capable of providing illumination for a preset period of time after activated (as recited in claims 1 and 5), as per the teachings of TSENG.

8. Regarding the preset intensity being greater than that resulting from normal purse operation (as recited in claim 2 and 6), it would have been obvious to one of

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ordinary skill in the art at the time the claimed invention was made to set the activation level of the vibration activated switch to a level greater than that resulting from normal purse operation, to prevent the illuminated key holder from being activated while stored in a purse.

9. Regarding the preset time interval being one minute or less (as recited in claims 3, 4, 7 and 8), it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to set the time interval to the claimed value, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). The actual preset time interval would have been an obvious matter of selecting the appropriate value for a specific application.

Response to Arguments

10. Applicant's arguments filed July 28, 2005 have been fully considered but they are not persuasive.

11. Regarding the Examiner's rejection of claims 1-8 under 35 U.S.C. 103(a) as being unpatentable over HSUEH (U.S. Pat. 6,334,692) and TSENG (U.S. Pat. 5,709,464), the applicant argues that the proposed modification of the patented structure of HSUEH is unobvious as it goes against the teachings of HSUEH and

prevent it from functioning as intended. The applicant cited several portions of columns 1 and 2 of HSUEH to support the arguments.

12. In response to applicant's arguments that proposed modification of the patented structure of HSUEH is unobvious, the applicant is respectfully directed to column 1, lines 12-18, where HSUEH states: *Typical decorative members may include one or more light devices provided therein and controlled by one or more switches. The light devices may be actuated only when the switches are actuated. However, once the light devices are actuated by the switches, the light devices may not be turned off until the switches are actuated again, such that electricity may be wasted.*

While the applicant interprets the cited statement as HSUEH teaching away from the patented device being activated for a pre-set period of time by actuation of the vibration switch, such interpretation is in error.

HSUEH is concerned with providing an illumination device activated by a first actuation of a switch, such device not requiring a second actuation of the switch for the illumination be turned OFF. The disclosure of HSUEH implies that such conventional devices have being activate they remain ON until the power source is exhausted, as a user might not remember to actuate the switch a second time to turn the device OFF. The patented device of HSUEH solves this problem by powering the light source only when the switch is actuated and by using a vibration switch. Once the vibration switch stops being vibrated the light source is immediately turned OFF.

TSENG, on the other hand, teaches a timing circuit for use in illumination devices, such circuit, once activated, energizing a light source for a pre-set interval of

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time, then turning such light source OFF (column 2, lines 9-16). The illumination circuit of TSENG provides large area illumination and eye-catching flashing effects, while at the same time consuming very little electric energy (column 1, lines 30-36).

Using the timing circuit of TSENG in the illumination device of HSUEH would have flown naturally to one of ordinary skill in the art at the time of invention to be able to provide a decorative eye-catching flashing light effect (as desired by both HSUEH and TSENG) without having to actuate a switch to turn the device OFF (as required by HSUEH) to save energy (as desired by both HSUEH and TSENG). This new device will have all the advantages of the previous patented device of HSUEH (e.g. energy efficient, and not requiring actuation of a switch for deactivation) and the added advantage of providing the desired decorative effects for a pre-set period of time after activation of the vibration switch (as per the teachings of TSENG).

As the applicant will now agree, HSUEH neither teaches away from the proposed modification, nor is rendered inoperative by such modification.

In addition, it is noted that TSENG states that the patented illumination circuit is designed to be used in a plurality of different articles such as clothing, shoes, purses, back packs, toys and the like, for illumination such articles and providing a decorative effect.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

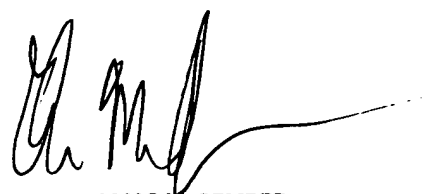
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



THOMAS M. SEMBER
PRIMARY EXAMINER


Inr

September 9, 2005